

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of:

Attorney Docket No.: 2733.35WOUS

Leung Choi Chow et al.

Confirmation No.: 4192

Application No.: 10/552,097

Examiner: Joshua J. Michener

Filed: February 21, 2006

Group Art Unit: 3644

For: LANDING GEAR ASSEMBLY

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is presented in response to the Examiner's Answer of May 24, 2011, and further to the Appellant's Appeal Brief of March 1, 2011. Appellant herein addresses issues raised by the Examiner in the Examiner's Answer and respectfully requests acknowledgement and entry of this timely filed Reply Brief.

Please grant any extension of time necessary for entry; charge any fee due and necessary for entry to Deposit Account No. 16-0631.

I. Status of Claims

Claims 15-29 and 31-35 are pending. Claims 1-14 and 30 have been cancelled. Claims 15-18, 20, 23, 27-29, and 33-35 stand rejected having been at least twice rejected. Claims 19, 21-22, 24 and 31-32 stand withdrawn from consideration.

II. Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 15-18, 20, 23, 27-29 and 33-35 are unpatentable under 35 U.S.C. § 103 over Hartel (US 3,133,717) in view of Roth (US 1,743,074) and whether claims 15-18, 20, 23, 27-29 and 33-35 are unpatentable under 35 U.S.C. § 103 over Labrecque (US 3,430,896) in view of Roth (US 1,743,074).

III. Argument

Review of the Examiner's Answer shows that the Examiner makes precisely the same argument in the "Response to Arguments" section with regard to the rejection of the claims on the basis of the combination of Hartel and Roth as he does for the rejection on the basis of the combination of Labrecque and Roth. As discussed in the Appeal Brief, the Examiner has admitted that certain limitation of the claims are not present in Hartel and Labrecque and relies on the Roth reference to support the rejection based on these limitations. The only real issue presented is whether Roth discloses the limitations in question. Accordingly, Appellants will address the repeated arguments only once.

A. Applicable Law

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a).

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir 1983), *cert. denied*, 469 U.S. 851 (1984).

“All words in the claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

MPEP 2142 cautions “knowledge of Appellants’ disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon Appellants’ disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.”

B. The Examiner’s Asserted Justification of the Interpretation of Roth based on the Broadest Reasonable Interpretation of the Claims Amounts to the Application of Impermissible Hindsight.

The Examiner asserts that his interpretation of the Roth prior art reference is justified based on his broadest reasonable interpretation of the claim language. Appellants respectfully traverse this assertion.

First, the prior art is analyzed for what it discloses or suggests to one of ordinary skill in the art. This analysis of the prior art should be independent from construing the claim language under the broadest reasonable interpretation. Otherwise, the Examiner is using impermissible hindsight contrary to the warnings of MPEP 2142. The conflation of claim construction and analysis of the teachings of the prior art suggests that the Examiner has fallen into impermissible hindsight analysis and has not properly considered the question of obviousness of the invention as a whole.

C. The Examiner's Purported Broadest Reasonable Interpretation of the Claim Language Does Not Meet the Standard for Reasonability.

Second, the Examiner's interpretation is not reasonable for at least the reasons discussed below. During examination, claim terms are to be accorded their broadest reasonable interpretation. *In re Buszard*, 504 F.3d 1364, 1367 (Fed. Cir. 2007). In order to be considered "reasonable," however, an interpretation must be consistent with the specification in which the claims appear. *Id.* Care must be taken in construing claims so as not to import unnecessary limitations from the specification. See *E-Pass Techs., Inc. v. 3Com Corp.*, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). But, "claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest **reasonable** interpretation." *In re Okuzawa*, 190 U.S.P.Q. 464, 466 (CCPA 1976) [emphasis in original]. The broadest reasonable interpretation must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999).

In the Reply Brief as well as the prior Office Actions, the Examiner asserts a very broad interpretation of claim terms that is inconsistent with the specification of the application under appeal and is not the meaning one of ordinary skill in the art would apply to the claim language. The Examiner's interpretation is, therefore, unreasonable.

Specifically, the Examiner uses the claims term "the rim" broadly to incorporate elements 17, 23, 35, 32, and 34 as disclosed by Roth.

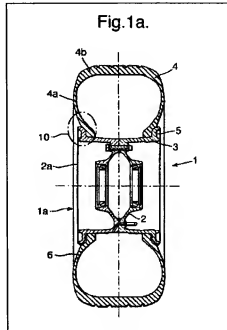
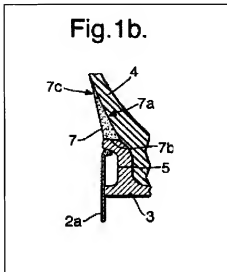
- a. The Examiner's Purported Broadest Reasonable Interpretation is not Consistent with the Specification.

First, this meaning is inconsistent with the specification of the present application which defines the structures of the wheel and rim. The Detailed Description of the Drawings defines the structures as follows "The wheel 1 comprises a hub 2 and a wheel rim 3. A tire is held in place on the wheel rim 3 by circumferential flanges 5." Paragraph 0033 Application as published. Based on the specification, the rim is the structure including circumferential flanges that holds the tire in place and nothing more. The Examiner's interpretation extends far beyond the description of the rim in the specification. Accordingly, the Examiner's interpretation of the claim language is not reasonable for at least this reason.

- b. The Examiner's Purported Broadest Reasonable Interpretation is not Consistent with the Understanding of One of Ordinary Skill in the Art.

Second, in the knowledge of one of ordinary skill in the art the rim is also understood to be a part of the wheel that engages the tire. The Roth reference, cited by the Examiner, supports this interpretation. Roth discloses that the "rim 17" has conventional flanges 22 and 23 which engage the tire 24 [Page 1; 86-88] and discloses that the other multiple elements (reference numerals 35, 32 and 34) that the Examiner asserts are part of the rim are separate and independent of the rim [Page 2, 11-24]. These structures are instead all identified by Roth as parts of the structure of the "windshield." The structures are secured to the spokes of the wheel away from Roth's rim and are plainly additional pieces that are not part of the "rim" as it would be understood by one of ordinary skill in the art according to Roth. The Examiner's interpretation of the claim language is not reasonable for at least this additional reason.

- c. The Examiner's Interpretation of the Drawings of the Present Application is Inaccurate.



Further, the Examiner argues that the very broad interpretation is supported “because as seen in Appellant’s specification (clearly shown in figures 1a, 1b, of the appellant’s spec, that the “rim” is at least 4 pieces on one side like a backwards lower case “h”). (sic) Based on this assertion the Examiner concludes “ Appellants’ “rim” of the tire/wheel assembly clearly has multiple parts/elements that make up the “whole” of the rim.” As can be seen in Figs. 1a and 1b, reproduced above, no separate pieces are apparent that have the appearance of “4 pieces on one side like a backwards lower case ‘h’.” Appellants invite the members of the Board to draw their own conclusions as to the interpretation of the drawings proposed by the Examiner.

The rim as depicted in a sectional view in Fig. 1a is a unitary structure and, as the Examiner’s argument is best understood by Appellants, any structures that appear “h” like referred to by the Examiner are an artifact of the sectional nature of the depiction and do not

exist as separate structures in the understanding of one of ordinary skill in the art. Accordingly, the Examiner's interpretation of the claim language is not reasonable for at least this third reason.

The Examiner's stated interpretation of the claim language is unreasonable for at least the reasons discussed above. Under a reasonable interpretation of the claim language neither the combination of Roth and Hartel nor the combination of Roth and Labrecque discloses or suggests all of the limitations of independent claims 15 or 28 and these claims cannot be rendered obvious by these combinations. Appellants respectfully request that the Board reverse the rejection of the claims on this basis.

D. The Examiner's Interpretation of "Wheel/tire assembly" is Not Supported by Evidence.

With regard to independent claim 28, the Examiner asserts "[a]s the 'wheel/tire' clause is written as an alternative because the "forward slash' in English text can be treated as an 'OR' clause, wherein the tire assembly at the widest part would be the widest part of the tire where the separate part interfaces thus meeting the scope of the claim." The Examiner cites no support for this assertion, which is not surprising since the assertion is incorrect.

A forward slash in English text does not mean "or." The most common use of the slash is to replace the hyphen or en dash to make a clear, strong joint between words or phrases, such as "the Hemingway/Faulkner generation." See for example, www.websters-online-dictionary.org. Wheel/tire assembly is properly understood to mean the assembly including a wheel and a mounted tire. Accordingly, this assertion does not support the rejections and the rejection of independent claims 15 and 28 should be reversed for at least this additional reason.

E. The Examiner's Assertion that the limitations "the separate part that fills the gap." are not part of the Claim Language is incorrect.

The Examiner contends that the claims do not recite the limitations "the separate part that fills the gap." While it may be true that these precise words are not present in the claims, claim 15 recites:

- (c) said separate part has
 - (i) a first surface that abuts the tire,
 - (ii) a second surface in contact with the rim, and
 - (iii) a third surface

which extends between the first surface and the second surface so as to provide a surface to *smooth and close the gap in the region of the junction between the tire and the wheel rim*. Emphasis added.

Thus, contrary to the Examiner's assertion, the concept that the separate part fills the gap between the rim and the tire is clearly recited in independent claim 15.

Further, as is clear from the discussion above, Roth does not disclose or suggest the "separate part" as claimed. Instead, Roth discloses annular rubber lip 36, identified by the Examiner as the separate part, is between the tire and the other parts of the "windshield" (annular portion 32, inner leg 34 and inwardly laterally extending flange 35. The other cited prior art does not disclose such a structure. Thus, the rejection of claim 15 should be should be reversed for at least this reason.

F. The Examiner's Third Alternative is Unsupported by the Evidence cited.

The Examiner asserts for the first time in the Examiner's Answer that

the combination of with the primary reference of Hartel in view of Roth, under a much narrower interpretation to what constitutes a “rim” that, it would have lead one of ordinary skill to the obvious conclusion that the secondary piece of prior art to Roth’s “separate piece” with a “second surface” when combined, would clearly be obvious that the second surface would touch a portion of the rim.

The Examiner repeats precisely the same argument related to the combination of Roth and Labrecque but for the substitution of the name “Labrecque” for “Hartel.” The Examiner cites no evidence in either the Hartel or Labrecque reference as to why this might be the case and neither Hartel nor Labrecque make any such disclosure or suggestion because, as admitted by the Examiner, neither reference discloses or suggests a separate part or second surface as claimed.

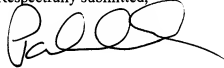
Thus, this argument does not justify rejection of either independent claim 15 or 28 as obvious. Accordingly, independent claims 15 and 28 should be patentable and the claims that depend from them should be patentable for at least the same reasons as the independent claims from which they depend. Appellants respectfully request that the Board reverse the rejection of the claims.

IV. Summary

For the reasons discussed above and in the Appeal Brief, claims 15-18, 20, 23, 27-29 and 33-35 are not properly rejected as being unpatentable over Hartel in view of Roth and over Labrecque in view of Roth.

It is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Paul C. Onderick', with a long horizontal flourish extending to the right.

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